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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,499	01/18/2002	John A. Galbraith	02-093	3656

7590

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/053,499	Applicant(s) GALBRAITH ET AL.	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. Claims 3-7, and 31-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2-6 and 31-36 the phrases corresponding to the thickness and protrusions to the stages of compression and responses to compressive forces are confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 18, 20, 26, and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sessa (54690639).

Sessa shows an insole comprising a base (22) with a plurality of compressible protrusions (36) and means for interconnecting the protrusions (38) which inherently provides for strict compression of the protrusions and column-buckling is avoided, i.e. the presence of 38 prevents the protrusion 36 from buckling over because it would interfere with the buckling when the protrusion hits it.

In reference to claim 29, the insole of Sessa is clearly capable of being placed, i.e. is adapted to be disposed between a foot and an insole inasmuch as applicant has claimed such.

4. Claims 1-7, 12-14, 17-26, and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Yung –Mao (4843741).

Yung-Mao shows an insole comprising a base (38) with a plurality of compressible protrusions (40) and means for interconnecting the protrusions (shorter elements or alternating elements 40) which inherently provides for strict compression of the protrusions and column-buckling is avoided, i.e. the close arrangement of elements 40 results in the elements abutting one another during compression which inherently avoids buckling of the elements.

In reference to claims 24 and 25, Yung-Mao shows an arch stiffener (30 at the area shown in figure 1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 12-18, and 23-36 are rejected under 35 U.S.C. 103(a) as being under 35 U.S.C. 103(a) as being unpatentable Kramer (5233767) in view of Wen (5853844).

Kramer shows an insole comprising a base member (25 or 10) with a plurality of protrusions (11 and/or 20) and means for interconnecting the protrusions (alternating elements 11 or elements 21 and other height elements as discussed in column 5 lines 20-24) substantially as claimed except for the orientation of the protrusions being away from the wearer's foot. Wen teaches placing protrusions (62 and 63) on the bottom surface of a base member (6) which top surface is located directly adjacent the wearers' foot as an alternative or in addition to placing cushioning protrusions on the upper surface of a midsole/outsole layer (2). It would have been obvious to provide the protrusions and interconnecting means on the bottom surface of an insole layer as taught by Wen in the shoe of Kramer to increase cushioning and comfort.

#### ***Response to Arguments***

7. Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the prior art not being "insoles", the prior art does show insoles in that they disclosed elements which either are in contact with the wearers' foot or at least are an upper layer of a sole, i.e. the definition of an insole. There is no clear structural difference between an upper layer of a sole/midsole and an insole. Absent any further structural limitations the claims are read broadly as is reasonable.

In response to applicants' arguments directed towards the avoidance of buckling, the applied prior art clearly shows such as described above in the rejections. Specifically Sessa shows relatively low height protrusions which would not be able to buckle,

furthermore the present of shorter protrusions 38 would assist in preventing and buckling. In reference to Yung-Mao, Yung-Mao specifically discusses that the arrangement and size of the elements "prevents undue bending or nonradial deformation" (column 4 lines 49-50), i.e. prevents buckling. In reference to Kramer, specifically discusses the protrusions "bulging", not buckling and therefore the shape and arrangement shown by Kramer meets the non buckling language of the claims (see column 3 lines 1-12).

In response to applicants' arguments directed towards the orientation of the device of Kramer, Kramer clearly suggests orienting the protrusions away from the foot in column 3 lines 1-5, i.e. "or point downwardly from such top-sole".

In response to applicants' arguments directed towards the material of the base of Kramer, Kramer clearly states that the entire element 10 including the base and the protrusions are made from soft elastic thermoplastic material (see column 4 lines 48-68).

### ***Conclusion***

8. This is a RCE of applicant's earlier Application No. 10/053499. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728